



UNITED STATES PATENT and TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re application of
Hong Shih et al.
Serial No. 09/489,356
Filed: January 21, 2000
For: COATING BORON CARBIDE ON ALUMINUM

: DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed November 5, 2002.

On April 25, 2002, a non-final office action was mailed to applicant rejecting all of the claims under 35 USC 103. A reply to the office action was filed by applicants on July 16, 2002. In the reply, applicants made several amendments to the claims and presented new claims. A final office action was mailed by the office on December 5, 2002 containing new grounds of rejection. Applicants filed an after final amendment on December 18, 2002 and made a request to have the finality of the December 5, 2002 office action withdrawn. This request was not addressed in the advisory action mailed January 6, 2003.

On January 17, 2003 the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the December 5, 2002 office action.

Petitioner's position for the withdrawal of the finality is that the new grounds of rejection in the final office action were not necessitated by applicant's amendments to the claims.

DECISION

Section 706.07 of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Petitioner argues that because claims 1 and 13 were not amended by applicants in the response filed July 16, 2002, the new grounds of rejection were clearly not necessitated by applicant's amendments to the claims. This is clearly the case and the argument is persuasive. The finality of the office action was in fact improper.

Accordingly, the petition for withdrawal of finality is **GRANTED**. Because the finality has been withdrawn, the amendment filed on December 18, 2002 will be treated as an amendment under 1.111 and will be entered. The examiner will consider the claims in light of said amendment and prepare a new non-final office action.

Jacqueline M. Stone

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

APPLIED MATERIALS, INC.
2881 SCOTT BLVD. M/S 2061
SANTA CLARA CA 95050